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REMARKS

Applicant thanks the Examiner and his supervisor for the courtesy extended to Applicant's representatives Messrs. Lawrence T. Cullen and Takehiko Yonezawa during an interview on April 27, 2004.

During the interview, Applicant presented a draft amendment to claim 49 which is substantially similar to above claim 49. Applicant explained the operation of the invention and explained that the claims "second address indicator" did not constitute a binary counter by the language of the claim, which recites that the number of positions indicated is not a natural number which is a power of 2. Applicant also explained that the phrase "the number of processing target instructions being any natural number except for a power of 2" does not state that an infinite number of instructions are included, but that simply numbers of instructions which are a power of 2 are excluded. It is Applicant's understanding that the Examiner's appreciated Applicant's position but decided to take the matters under further consideration upon the filing of this response.

I. Introduction

Claims 2-11 and 49-51 are pending in the above application.

Claims 1-11 and 49-50 stand rejected under 35 U.S.C. §112 ¶1.

Claims 1-11 and 49-50 stand rejected under 35 U.S.C. §103.

Claims 49, 50 and 51 are the independent claims.

II. Amendment

Claims 49 and 51 have been amended to better conform to conventional U.S. claim

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drafting practices. Claims 49-51 have been amended to replace "first program counter" with "first address indicator", and to replace "second program counter" with "second address indicator". Support for these limitations may be found at least in Figure 3A-3C and 6, and described at least at pages 33-49 of the specification.

Claims 1-11 have been amended to conform to the amendments to claim 49.

No new matter has been added by the amendments.

III. Rejections Under 35 U.S.C. §112 ¶1

Claims 1-11 and 49 and 50 stand rejected under 35 U.S.C. § 112, first paragraph on the basis that "an arbitrary number" of target instructions "lack support in the specification."¹

Applicant respectfully traverses the rejection at least for the reasons presented in Applicant's response filed on March 30, 2004, incorporated herein, and the reasons set forth below.

The Examiner is respectfully reminded that, it is well established that the words used in the claims are examined through the viewing glass of a person skilled in the art. See, *Tegal Corp. v. Tokyo Electron Am., Inc.*, 257 F.3d 1331, 1342, 59 USPQ2d 1385, 1393 (Fed. Cir. 2001). See also, MPEP 2111, pg. 2100-47, "the broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach", citing *In re Cortright*, 165 F.3d 1353, 1359 (Fed. Cir. 1999).

To the extent that the Office action is asserting that an arbitrary number of instructions is not supported by the specification, Applicant respectfully traverse, and direct the Examiner to

¹ Applicant notes that it is not clear if the rejection is under the written description provision of §112 or the enablement provision. As the Office action does not discuss any factors of enablement, it is presumed the rejection is for an alleged lack of written description. See, MPEP 2164. To the extent that the rejection is maintained, Applicants respectfully request clarification.

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lines 2-14 on page 35 of the specification, which indeed makes it clear that "in instruction units" may be used. Moreover, one of skill in the art would readily be able to determine an appropriate number of instructions based on Applicant's disclosure at least by following the guidance provided in the equations on page 35.

The rejection appears to be based on the claim phrase "the number of processing target instructions being any natural number except for a power of 2." To the extent that the rejection is asserting that this phrase states that an infinite number of instructions may be used, Applicant's respectfully traverse. As properly understood by one of skill in the art, this phrase does not state an infinite number of instructions are included, but that simply numbers of instructions which are a power of 2 are excluded. Moreover, those of skill in the art will readily appreciate that an instruction must have a minimum bit length, which would limit the number of instructions in a packet of a fixed bit size. Accordingly, the number of instructions which are available would not be understood by those of skill in the art to be an infinite number, but would be within practical boundaries of the art and within the spirit of the disclosed invention.

Accordingly, Applicant respectfully requests the rejections to be withdrawn.

IV. Rejection Under Prior Art

Claims 2-11 and 49-51 stand rejected under 35 U.S.C. §103 as being unpatentable over Christie et al. (U.S. Pat. 5,559,975)(hereafter "Christie").

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *Ecolochem Inc. v. Southern California Edison Co.*,

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227 F.3d 1361, 56 U.S.P.Q.2d (BNA) 1065 (Fed. Cir. 2000); *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2D (BNA) 1614, 1617 (Fed. Cir. 1999); *In re Jones*, 958 F.2d 347, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992); and *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). See also MPEP 2143.01.

Christie does not disclose or suggest a processor for reading instructions from a memory which includes a memory configured to store, in a position corresponding to a byte boundary, at least one processing packet being made of a natural number of bytes, the processing packet including processing target instructions, each processing target instruction being an operation to be executed by the processor, the number of processing target instructions being any natural number except for a power of 2; a first address indicator configured to indicate a storage position of the processing packet in the memory; and a second address indicator configured to indicate a position of a processing target instruction in the processing packet by using the same number of positions as the number of processing target instructions, and cycling through the positions, wherein after the second address indicator finished cycling through the positions, the first address indicator indicates the next storage position of the processing packet in the memory, as recited by amended claim 49, and substantially recited by amended claim 50. Christie discloses to use a conventional counter to count binary address positions in a memory. Abs., Figs. 1-2 and 4-5, col. 8, ll. 4 through col. 11, ll. 39. Christie does not disclose or suggest to use a number of processing target instructions which are not a power of 2, nor to use an address indicator configured to indicate a position of a processing target instruction in the processing packet by using the same number of positions as the number of processing target instructions, and cycling through the positions, *i.e.* a number of positions which are not a power of 2. Indeed, the Office action appears to recognize this failure of Christie. Office action, page 7.

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However, the Office action appears to assert, without citation to any reference or authority, that "the difference is only the exclusive number of implementation, where the number is conforming to standards in size in accordance to the length of a given instruction set."

However, it is well established that a rejection must be based on factual evidence, not mere speculation. See, *In re Lee*, 277 F.3d 1338 (Fed. Cir. 2002) "deficiencies of the cited reference cannot be remedied by the Board's general conclusion about what is 'basic knowledge' or 'common sense' ... common knowledge and common sense ... do not substitute for authority."

In short, there is simply no suggestion in Christie or the prior art to use an address indicator configured to indicate a number of positions of a processing target instruction which are not a power of 2. To the extent that the rejection is maintained, the Examiner is respectfully requested to particularly point to objective factual evidence to support the assertions.

The Office action goes on to assert that "structural similarity" is achieved. However, it is well established that the actual claimed invention must be produced to establish a prima facie case of obviousness, producing something which is allegedly similar to the claimed invention does not establish a prima facie case of obviousness. See MPEP 2143 "to establish a prima facie case of obviousness ... the prior art reference ... must teach or suggest **all claim limitations**" (bold added for emphasis). Accordingly, the Office action clearly has not established a prima facie rejection.

Moreover, the Examiner is respectfully reminded that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is **some teaching, suggestion, or motivation to do so** found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *Ecolochem Inc. v. Southern California Edison Co.*, 227 F.3d 1361, 56 U.S.P.Q.2d (BNA) 1065

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(Fed. Cir. 2000); *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2D (BNA) 1614, 1617 (Fed. Cir. 1999); *In re Jones*, 958 F.2d 347, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992); and *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). See also MPEP 2143.01. It should be recognized that the fact that the prior art could be modified so as to result in the combination defined by the claims at bar would not have made the modification obvious unless the prior art suggests the desirability of the modification. *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986). Recognizing, after the fact, that such a modification would provide an improvement or advantage, without suggestion thereof by the prior art, rather than dictating a conclusion of obviousness, is an indication of improper application of hindsight considerations. Simplicity and hindsight are not proper criteria for resolving obviousness. *In re Warner*, 379 F.2d 1011, 154, USPQ 173 (CCPA 1967). In the present case, the Office action does not appear to provide any motivation to produce the claimed invention, and does not even appear to purport to produce the claimed invention at all.

V. CONCLUSION

Having fully and completely responded to the Office Action, Applicants submit that all of the claims are now in condition for allowance, an indication of which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, the Examiner is requested to call Applicants' attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including

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extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,
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